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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/782,687

02/19/2004

Kamal Jain

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EXAMINER

ERB, NATHAN

ART UNIT

PAPER NUMBER

3628

MAIL DATE

DELIVERY MODE

07/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/782,687

Applicant(s)

JAIN ET AL.

Examiner

Nathan Erb

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-25 is/are allowed.
- 6) ☒ Claim(s) 1-22, and 27-30 is/are rejected.
- 7) ☒ Claim(s) 3, 5, 11, 14, 16, 20, 26-27, and 29-30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 20040607.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Objections***

2. Claims 3, 5, 11, 14, 16, 20, 26-27, and 29-30 are objected to because of the following informalities:

- a. In the first line of claim 3, please remove the comma after the word "vector."
- b. In the first line of claim 5, please replace the word "utilizes" with --utilizing--.
- c. In the first line of claim 11, please replace the word "yields" with --yielding--.
- d. In the first line of claim 14, please remove the comma after the word "vector."
- e. In the first line of claim 16, please replace the word "utilizes" with --utilizing--.
- f. In the second line of claim 20, please replace the word "yields" with --yielding--.
- g. In the second line of claim 26, please replace the word "employs" with --employing--.
- h. In the second line of claim 26, please insert the word --price-- after the word "one."
- i. In the fourth line of claim 27, please replace the phrase "agent related" with --agent-related--.
- j. In the first line of claim 29, please insert the word --item-- after the word "one."

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k. In the first line of claim 30, please replace the word “employing” with the word --containing--.

l. In the first line of claim 30, please insert the word --item-- after the word “one.”

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 29-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 29-30 are written in “single means claim” format since they recite only one element to do all the functions recited. The claims are not written in “means-plus-function” language, however, in *Fiers v. Revel*, (CAFC) 25 USPQ2d 1601, 1606 (1/19/1993), the CAFC affirmed a rejection under 35 USC 112 of a claim reciting a single element that did not literally use “means-plus-function” language. Claims 29-30 are drawn to any of the listed devices, regardless of construct, that perform the function recited. This parallels the fact situation in *Fiers* wherein “a DNA” and a result was recited. The CAFC stated in *Fiers* at 1606 “Claiming all DNA’s that achieve a result without defining what means will do so is not in compliance with the description requirement; it is an attempt to preempt the future before it has arrived”. See also *Ex parte Maizel*, (BdPatApp&Int) 27 USPQ2d 1662, 1665 and *Ex parte Kung*, (BdPatApp&Int) 17 USPQ2d 1545, 1547 (1/30/1989) where the claims at issue were rejected for being analogous

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to single means claims even though “means” was not literally used. Thus, claims 29-30 yield “devices” that achieve a result without defining what will do so.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **Claim 28**, it is not clear what exactly “computer executable components” are, and thus the claim is indefinite. Examiner recommends replacing the phrase “computer executable components of the system” with “computer-executable instructions for the system” to help overcome this rejection.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Regarding claim 1, from which claims 2-11 depend, applicants’ specification, on p. 5, lines 20-24, states that a “component” may be only a computer program. Therefore, claim 1 is directed to a computer program, without the computer-readable medium needed to realize the computer program’s functionality. Therefore, the claim is directed to nonstatutory functional descriptive material. See MPEP 2106.01(I).

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9. Claims 12-22 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter. In order to be patentable, an invention involving a mathematical algorithm must produce a useful, concrete, and tangible result. State Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596, 1600-1601 (Fed. Cir. 1998).

The inventions of these claims do not produce tangible results, for example, some sort of perceivable communication that transmits their calculated results to a user. This could be a step producing a chart, printout, or computer monitor display; however, there are no such outputs in these claims. Therefore, these claims do not produce tangible results and are not patentable.

10. Claim 27 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A claimed data packet is neither a process, machine, composition of matter, nor manufacture. Therefore, claim 27 does not fall within any of the categories of patentable subject matter under 35 U.S.C. 101 and is not patentable.

#### ***Allowable Subject Matter***

11. Claims 23-25 are allowed.

12. Claim 28 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

#### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Erb whose telephone number is (571) 272-7606. The examiner can normally be reached on Mondays through Fridays, 8:30 AM to 5 PM.

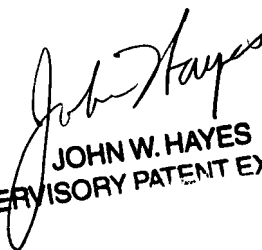
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nathan Erb  
Examiner  
Art Unit 3628

nhe

  
JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER